

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Vincent R. Koser	§	Group Art Unit:	4127
		§		
Serial No.:	10/631,181	§	Conf. No.:	1439
		§		
Filed:	July 31, 2003	§	Examiner:	Rodney M. Henry
		§		
For:	SYSTEM AND METHOD FOR EXECUTION OF CUSTOMER- SPECIFIC MARKETING, DISCOUNTS, AND PROMOTIONS	§	Atty. Dkt. No.:	11446.10
		§		
		§		
		§		

Mail Stop: AF  
Commissioner for Patents  
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PRE-APPEAL BRIEF AND REQUEST FOR REVIEW

Dear Sir:

Applicant respectfully requests review of the final rejection, mailed June 8, 2010, in light of the pre-appeal brief that follows. No amendments are being filed with this request and this request is being filed with a Notice of Appeal.

102(e) Rejection of Independent Claims 1, 3, 4, 20 and 22 by Swartz

The Office has failed to establish a *prima facie case* of anticipation because it has failed to show the reference is anticipatory as required by section 102(e). The court teaches, “for a claim to be anticipated, each claim element must be disclosed, either expressly or inherently, in a single prior art reference, and the claimed arrangement or combination of those elements must also be disclosed, either expressly or inherently, in that same prior art reference.” (*Therasense, Inc. v. Becton, Dickinson*, 593 F.3d 1332-1333, January 25, 2010.) The rejection is improper because the Office has failed to show that the prior art discloses each claim element and has further failed show the claimed arrangement of the elements. Applicant requests that the rejections be withdrawn and all claims allowed.

Swartz teaches a portable terminal having an integrated machine code reader. A customer uses the terminal to scan items selected for purchase as the customer moves through a store shopping for the items. The customer can also receive information about a scanned item. Swartz teaches “if a customer scans a product ... the portable terminal can access a database to provide additional information about the product, such as recipe, nutritional information, instructions on use, government subsidized information, etc.” (Paragraph 46.)

Regarding claim 1, Applicant requires, *inter alia*, the following: a point-of-sale computer, a customer interface device and a local promotional server. Applicant further requires, “a point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification by the point-of-sale computer.” Applicant requires that items for purchase be presented to the checkout counter for scanning and identification. Swartz teaches that items for purchase are scanned by the portable terminal as the customer moves about a store. Swartz portable terminal is clearly not a checkout counter and therefore does not meet Applicant’s requirements. It is further unclear if the Office has attempted to actually address this required element. The Office cites four references within Swartz but fails to tie any of the citations to Applicant’s required elements. A citation to paragraph 52 states “the portable terminal may be used as part of a kiosk to provide a fixed station for presenting pricing data, advertising and customer assistance.” (The Office underlined the text.) However, this teaching fails to show that items are scanned at the kiosk or by the portable terminal at the kiosk or that the kiosk is involved in purchasing any items. The Office has failed to show how Swartz teaches these required elements.

Applicant requires “a customer interface device at the checkout counter and in communication with the point-of-sale computer for alerting a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer and for transferring details of the promotion to the point-of-sale computer, wherein the details of the promotion appear as bar code data to the point-of-sale computer.” The Office states “see [FIGS 6,9, para 0211] via The system could also use the information in determining whether to send a promotional message to a customer.” (Office action, page 3.) The quote is taken from paragraph 211 which also states prior to the Office’s quote,

“The system may utilize the information stored in the customer shopping list to select messages to send to the customer.” The passage cited by the Office teaches that information stored in a customer shopping list is used to determine whether to send a promotional message to a customer. This is clearly not what Applicant requires. Applicant requires “alerting a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer.” The Office has failed to show these required elements.

Additionally, the customer interface device requires “transferring details of the promotion to the point-of-sale computer, wherein the details of the promotion appear as bar code data to the point-of-sale computer.” A citation by the Office states “see [para. 0108] via The code could be in the form of a one dimensional barcode for looking up the relevant information in a database.” (Office action, page 3.) The prior two sentences of paragraph 108 state “The receipt printer prints out the entire list of all purchased items. The receipt preferably has a code for determining all of the products (and their cost) purchased by the customer. The code could be in the form of a one dimensional barcode ...” The code referenced here and by the Office is printed on a receipt. There is no teaching that a customer interface device is involved in any way. Additionally, there is no teaching that a customer interface device transfers details of the promotion to the point-of-sale computer using a bar code. The Office has failed to show these required elements.

Applicant requires “a local promotional server wirelessly connected to the customer interface device for sending the details of the promotion to the customer interface device.” Applicant is unsure if the Office addressed the element or not. The Office states in the middle of a passage, “... an TBM 4680/90 or similar computer which includes price information and maintains statistical data as to purchases, discounts, inventory, and promotional information.” (The Office added the underline.) (Office action, page 3.) The computer described here maintains statistical data as to promotional information. The passage does not teach a promotional server or that the computer has details of a promotion or that details of a promotion are sent to the customer interface device. The only teaching is that statistical data as to promotional information is maintained. This teaching does not show Applicant’s required elements.

For any or all of the above reasons, the Office has failed to show that Swartz teaches all the elements required by Applicant or that Swartz properly anticipates Applicant's claimed invention as arranged. Therefore, the rejections based on 102(e) are improper and Applicant requests that they be withdrawn.

*Re: Claim 3, 4, 20 and 22:*

The rejections for these claims are improper for one or more of the same reasons given above for claim 1 and should therefore be allowed for the same reasons.

103(a) Rejection of Dependent Claims 8, 14 and 19 by Swartz and Sloane

Sloane teaches a system and method for influencing and potentially altering a consumer's purchase decisions at the point-of-purchase in a retail store using a portable bar code scanner. (See Sloane abstract.) Sloane's teachings also fail to show or suggest the above elements that the Office has failed to show were disclosed by Swartz.

The Office has failed to establish a *prima facie* case of obviousness because it has failed to provide evidence that the references show or suggest all the required elements of Applicant's claimed invention. The rejection is therefore improper and Applicant requests that it be withdrawn.

103(a) Rejection of Dependent Claim 15 by Swartz, Sloane and Panofsky

Panofsky teaches "a system and method for the contemporaneous use of a vending machine and host terminal to interact with digital files." (Panofsky, Abstract.) Panofsky's teachings also fail to show or suggest the above elements missing from the other references cited by the Office.

The Office has failed to establish a *prima facie* case of obviousness because it has failed to provide evidence that the references show or suggest all the required elements of Applicant's claimed invention. The rejection is therefore improper and Applicant requests that it be withdrawn.

## CONCLUSION

For any or all of the reasons stated above, Applicant asks that the rejections be withdrawn and that all claims be allowed. Please charge any fees that might be due, excluding the issue fee, to deposit account 14-0225.

Respectfully submitted,

Date: November 8, 2010  
(Electronically Submitted)

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